

III. REMARKS

Status of the Claims

Claim 1 is canceled and new claim 20 is added. Claims 3,4,13,15-19 are amended to be dependent on new claim 20. Claims 3-11, 13, and 15-20 are presented for further consideration.

Summary of the Office Action

Claims 3-6, 15, 18, and 19 stand rejected under 35USC103(a) on the basis of the cited reference Prior (EP000913977A2) in view of the newly cited reference Takafumi(JP11284706). Claim 7 stands rejected under 35USC103(a) on the basis of the reference Prior in view of Takafumi and further in view of the reference Davidson, et al, U.S. Patent No. 5,841,855. Claims 8-11 stand rejected under 35USC103(a) on the basis of the reference Prior in view of the reference Takafumi and further in view of the reference Bannister (2012199). Claims 13, and 17 stand rejected under 35USC103(a) on the basis of the reference Prior in view of the reference Takafumi and further in view of the reference Gordon, U.S. Patent No. 5,884,156. Claim 16 stands rejected under 35USC103(a) on the basis of the reference Prior in view of the reference Takafumi and further in view of the newly cited reference Fishman, U.S. Patent No. 5,655,017.

Applicant has amended the claims to clarify the novel features of the invention for which protection is sought in this application. These amendments are submitted after final rejection in order to place the claims in condition for allowance or in the alternative to place the claims in better condition for appeal. The Examiner is requested to exercise his discretion and enter these amendments.

In rejecting the claims, the examiner has cited, for the first time, the reference Takafumi as a basis for the obviousness rejections. The citation of this new reference was not necessitated by Applicant's prior amendments and accordingly the issuing of final rejection is improper under MPEP section 706.07(c) where it is stated:

"While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant, who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application."

The Examiner is respectfully requested to reconsider the final nature of the pending office action and his rejection in view of the above amendments and the following arguments. The entering of the above amendments will permit the clarification of the issues for appeal or the allowance of the claims.

Discussion of the Cited References

The Examiner relies primarily on the reference Prior, et al to support the rejection of the claims in this application. The reference Prior describes a mobile telephone having a single user interface which may have certain features on the rear face of the telephone. This is described in column 3, lines 30-35 as follows:

"Moving user interface features from the front face of the handset to another face or faces enables the phone to be reduced in size, particularly in length. Moreover, it often results in a ergonomically improved handset. For example, keys placed on the rear of the handset assist single handed operation, enable more accurate operation as they are actuated using a finger instead of a thumb and are more accessible when the user is in a call"

The functional elements placed on other faces including the rear face are just extended parts of a single user interface and do not operate independently. When the interface features on the front of the handset are obstructed, the handset is in operable. This is not the case with respect to the mobile telephone described in new claim 20 now under consideration. It is now clear that the third functional elements provide a means, with said second functional elements to operate the radio telephone when the first functional elements are obstructed. Such obstruction frequently occurs when the radio telephone is mounted in a carrier.

The reference Prior, et al fails to disclose a key feature of the subject invention, as defined in new claim 20. None of the additional references cited by the Examiner remedy this deficiency. The examiner's rejection of the claims under consideration, based on obviousness, is therefore, not supported by the cited references either alone or in combination.

It does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

The U.S. Court of Appeals for the Federal Circuit recently indicated that it is important to be careful in cases which are technologically less complex as,

"the very ease with which the invention can be understood increases the risk of a hindsight syndrome in which the teachings of the inventor are used against the inventor himself." (Ruiz v. A.B. Chance Co., Fed. Cir., No.99-1557, 12/6/00).


Applicants submit that this is what is occurring in the present application.

Applicants further submit that claim 20 defines patentable subject. Accordingly, since all of the claims remaining in this application are now dependent from claim 20, each define patentable subject matter.

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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